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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------------|
| 10/069,580 | 05/17/2002 | Hidetoshi Sugiyama | ASA-1069 | 3826 |
| 24956 7590 08/17/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314 | | | EXAMINER LEVKOVICH, NATALIA A | |
| | | | ART UNIT 1743 | PAPER NUMBER |
| | | | MAIL DATE 08/17/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,580

Applicant(s)

SUGIYAMA ET AL.

Examiner

Natalia Levkovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on interview conducted 02/06/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-34, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) 17-22, 29-34 and 37-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 17-34, 37 and 38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

D DETAILED ACTION

1. This Office Action replaces the previous Action and sets a new statutory time period for response.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Election/Restrictions

3. The previous Office Action included a restriction requirement in which paragraphs of the US restriction rules were mistakenly used. Examiner regrets the inconveniences caused by the error and replaces paragraph 2 of the prior Action with a new restriction, based on PCT rules and the lack of unity concept, as follows:

Restriction is required under 35 U.S.C. 121 and 372.

The amended claims 17-22, 29-34 and the newly submitted claims 37-38 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

The original claims 1-16 were, and the currently amended claims 23-28 are drawn to an automatic analyzer comprising a 'control part' that determines whether or not the uppermost rack has been properly separated (invention I);

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The amended claims 17-22 are drawn to an automatic analyzer comprising a particular arrangement of belts and motors and a controller for determining a quantity of the remaining part racks (invention II);

The amended claims 29-34 are drawn to a part feeding device comprising a 'controller means' for determining a quantity of the remaining racks (invention II);

New claims 37-38 are drawn to a method of controlling an automatic analyzer (invention IV);

The only technical features common for these inventions are one or two lifters, a rack separator and two sensors. These features do not contribute any novelty over the prior art. For example, Miura et al. (US 5190434) disclose lifters 3, 4; rack separator 150 and a "plurality of detecting means ['sensors' – Ex.] for detecting the positions" of the lifters carrying part racks (see Figure 1; Col. 3, lines 33 plus).

Therefore, the unity of invention is lacking. In accordance with 37 CFR 1.499, applicant is required to elect a single invention to which the claims must be restricted.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-22, 29-34 and 37-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. Claim 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23, as amended, recites a 'supply lifter' and a 'recovery lifter' being mounted 'for vertical movement'. The claim further recites the lifters being mounted on the 'movable' table. It is unclear whether or not the intended table is configured to move vertically.

The amended claim 24 recites 'one or more sensors positioned to sense whether the uppermost part rack has been properly separated' from the stacked racks. For the 'one-sensor' arrangement, it is unclear how a single sensor can simultaneously detect positions of at least two different racks (the uppermost rack and a lower one). In the absence of clear definition of what the 'proper separation' means and in light of Applicant's disclosure, it appears that at least two sensors would be needed for this purpose.

Claim 28 recites the 'alarm means for notifying an operator when a quantity of part racks' reaches a predetermined minimum. It is unclear what structural elements of the system would provide for such determination.

Allowable Subject Matter

5. Claims 23-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Although the closest prior art, Miura et al., disclose position detectors providing the controller with the information regarding a number of parts remaining in the racks, the reference fails to teach, or fairly suggest the part supplying system for an automatic analyzer with the controller being configured to determine whether or not the uppermost rack 'has been properly separated from the second rack from the top of the stack and to judge whether to continue or interrupt the operation, the determination being made based on the information received from the position sensors arranged to sense the two uppermost racks.

Response to Arguments

6. Applicant's arguments filed 08/10/2006 and 01/11/2007 have been fully considered but they are not persuasive, or moot in view of new grounds of rejection.

Applicant argues that the 'claims directed to a part feeding device have been present in the application 'since its filing'. Examiner notes that the originally filed claim 10 (drawn to a part feeding device) did not include the controller 'for determining a quantity of the remaining racks'. As was shown above, inventions II, III and IV are independent and distinct from the originally presented invention I. Examiner maintains that the restriction is proper.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700